

REMARKS

Introduction

This Reply is in response to the Office Action of August 15, 2006. Reconsideration of this application in view of the following remarks is respectfully requested.

The Claim Rejections

Claims 21 and 23-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg, fujifilm.net and Nozaki. Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg, fujifilm.net, Nozaki, and Plettinck. Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg, fujifilm.net, Nozaki, and Bruck. Claims 31-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg, fujifilm.net, Nozaki, and Weisman. These rejections are respectfully traversed.

Claims 21-30 and 32

Claim 21 has been amended to incorporate the features of former claim 31, which depended from claim 21.

Former claim 31 was originally rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg, Nozaki, and Weisman. On appeal, the Board of Patent Appeals did not sustain

this rejection.

In the present Office Action, the fujifilm.net has been added as a new reference to the §103 rejection. However, the fujifilm.net reference does not make up for the deficiencies of Oberg, Nozaki, and Weisman.

As amended, claim 21 is directed to using email messages that include URLs that allow recipients to view and order prints through a web browser. In the Office Action, it was suggested that Weisman discloses this feature (Office Action, page 6). In particular, it was urged that page 1 of Weisman's article teaches this limitation by "forwarding" a message in the Internet." The only passage on page 1 of Weisman that mentions "forwarding" states:

"Maybe you have been a member of a wedding recently. Maybe there was a professional photographer who carefully posed everyone, then mailed off proofs of the pictures who forwarded them to one person, who forwarded them to another, who forwarded them to a third. And maybe you waited for final pictures of the happy day."

This passage is plainly describing the process of mailing of wedding proofs from person to person through the regular mail, not by email through the Internet. The cited passage

therefore does not even disclose the emailing of images, let alone the emailing of URLs that allow parties to view and order prints.

Weisman therefore fails to show or suggest providing email messages containing URLs to message recipients so that the recipients can view and order prints through a web browser as set forth in claim 21.

In the Office Action, it was also stated that that fujifilm.net teaches sharing/distributing digital pictures to different parties on the internet. Regardless, there is nothing in fujifilm.net, Oberg, or Nozaki to suggest providing email messages containing URLs to message recipients so that the recipients can view and order prints through a web browser as set forth in claim 21.

Because Weisman, fujifilm.net, Oberg, and Nozaki fail to show or suggest providing email messages containing URLs to message recipients so that the recipients can view and order prints through a web browser as set forth in claim 31, claim 31 is patentable over Weisman, fujifilm.net, Oberg, and Nozaki. Claims 22-30 and 32 depend from claim 21 and are patentable because claim 21 is patentable.

Claims 39 and 40

Claim 39 has been amended to place it in independent

form, including the features of former independent claim 38, from which claim 39 previously depended. Claim 40 has been amended to depend from claim 39.

In the August 15, 2006 Office Action, claims 39 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oberg in view of the fujifilm.net article, Nozaki and Weisman. These rejections are respectfully traversed.

Claim 39 relates to ordering wood and metal framed prints of images taken by a photographer. To form the images for the prints, customers are originally photographed against a solid background. The resulting digital image is then manipulated to replace the solid color background with a new background. As defined in claim 39, the customer is provided with an on-line opportunity to order a print of the digital image that includes the customer with the new background.

The Oberg, fujifilm.net, Weisman, and Nozaki references do not show or suggest these features.

Claim 39 was originally rejected as being obvious based on the combination of Oberg, Weisman, and Nozaki. In making these rejections, it was argued that Weisman disclosed changing backgrounds. However, as applicants have previously explained, the "backgrounds" of Weisman that have been relied upon in rejecting applicants' claims are just the colors of the web pages on which the Memories Online website displays images

and do not replace any existing solid backgrounds against which customers were originally photographed.

The issue of whether Weisman discloses changing the backgrounds of pictures was considered by the Board of Patent Appeals during applicants' appeal. The Board of Patent Appeals decided that Weisman does not disclose the changing of backgrounds, stating "[t]hus, the changing of backgrounds discussed in Wiseman is the background of the album, (webpage) and not the background of the picture." (See page 11 of the May 15, 2006 Decision of the Board.) It has therefore already been decided that Weisman does not disclose changing the background of a picture as required by claim 39.

In the present Office Action, the fujifilm.net article has been added as a new reference. It is argued that fujifilm.net should be combined with the Oberg, Weisman, and Nozaki references under 35 U.S.C. §103 because merging/substituting technology is not new. However, the fujifilm.net article is completely silent about solid color backgrounds and makes no mention of changing backgrounds whatsoever.

Despite adding the new fujifilm.net reference to the §103 rejection, the Office Action continues to rely on the Weisman article as showing the changing of backgrounds of a picture and does not rely on the fujifilm.net article or the

Oberg or Nozaki references to show this feature. (Office Action, page 6). Because the Board of Patent Appeals has decided that the Weisman article does not show the changing of backgrounds of a picture as required by claim 39 and because fujifilm.net and the other references also fail to show or suggest the changing of backgrounds of a picture as required by claim 39, claim 39 is patentable over Oberg, Weisman, Nozaki, and fujifilm.net.

Claim 40 depends on claim 39 and is patentable because claim 39 is patentable.

Claims 33-37

Independent claim 33 relates to event photography. In particular, claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event. As set forth in claim 33, the order servicing equipment comprises an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print.

In the Office Action, claim 33 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oberg in view of fujifilm.net, Nozaki, and Weisman.

However, nothing in Oberg, fujifilm.net, Weisman, or Nozaki, relates to on-line systems for event photography having the customer list and assignment title features of claim 33.

On appeal, the Board of Patent Appeals decided that the previous §103 rejection of claim 33 was not sustainable because claim 33 recites two types of information (an assignment title which identifies the event and a customer list), whereas Oberg and Nozaki did not teach either of these types of information and Weisman at best taught a web address that was an analog to only one of these types of information. In the present Office Action, the fujifilm.net article has been added to the §103 rejection, but this does nothing to make up for the deficiencies of Oberg, Nozaki, and Weisman. In particular, there is nothing in the fujifilm.net article that shows or suggests the use of a customer list and assignment title (nor does the Office Action point to any such teaching in fujifilm.net).

On page 7 of the Office Action, it is argued that "for identification purpose, many practices have been required two separate/distinct information for verifying." However, just because two separate pieces of information have previously been used for verification purposes, it does not follow that the cited combination of prior art references renders claim 33 unpatentable under 35 U.S.C. §103(a). Claim 33 is not directed

toward the mere use of two pieces of information. Rather, claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event where an order servicing computer is provided with a customer list and uses an assignment title to identify the event. As the Board of Patent Appeals has explained, this feature is not shown or suggested by Oberg, Nozaki, or Weisman. It is also not shown or suggested by the fujifilm.net reference.

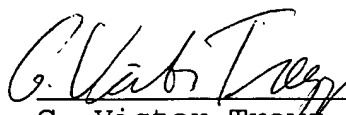
Because there is nothing in Oberg, Nozaki, Weisman, or fujifilm.net that shows or suggests the use of a customer list and assignment title in an online system for event photography, claim 33 is patentable. Claims 34-37 depend from claim 33 and are patentable because claim 33 is patentable.

Conclusion

In view of the foregoing, claims 21-30, 32-37, 39, and 40 are in condition for allowance. This application is

therefore in condition for allowance. Reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

 11/15/06

G. Victor Treyz
Reg. No. 36,294
Attorney for Applicants
Customer No. 36532